

## REMARKS

Claims 40-77 are pending. Claims 40, 44, 51, 56, 61 and 63 have been amended. Claims 78-81 have been added.

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### **Request for Continued Examination**

10 The present Amendment and Remarks are being submitted with a Request for Continued Examination (RCE) and the RCE fee. Applicants respectfully request entry of this amendment prior to initial examination.

### **Petition for Extension of Time**

15 A petition for a 3-month extension of time is enclosed along with a credit card payment form for the required fee.

### **Deposit Account Authorization**

20 Applicants believe that no additional fees are necessary at this time. However, in the event additional fees are required, Applicants authorize the Commissioner to take any necessary fees, including those under 37 CFR 1.16 and 1.17, from deposit account 50-0913.

### **A Brief Review of One Embodiment of Applicants' Invention**

25 In one embodiment of Applicants' invention a game includes a table having a card betting layout located on a surface of the table. A roulette betting layout is located on the surface of the table. A roulette wheel is mounted to the table. The game allows wagering and playing a

card game and a roulette game at the same time. A dealer operates the game. The games are independent of each other (see figures 1-3 and paragraphs 39-44).

### **Rejection under 35 U.S.C. 112**

5. The Office rejected claim 44 under 35 U.S.C. 112 as being indefinite. Claim 44 has been amended to more clearly recite the invention. Withdrawal of the 112 rejection is respectfully requested.

### **Rejection under 35 U.S.C. 103(a)**

- 10 The Office rejected claims 40-44, 46, 48-51, 54-64, 66-70, 72, 74, 75 and 77 under 35 U.S.C. 103(a) as allegedly being anticipated by U.S. Patent No. 6,656,040 issued to Brosnan in view of U.S. Patent No. 6,302,395 issued to Astaneha.

- Claims 45, 71 and 73 were rejected under 35 U.S.C. 103(a) as allegedly being anticipated by U.S. Patent No. 6,656,040 issued to Brosnan in view of U.S. Patent No. 5,743,800 issued to  
15 Huard.

Claims 47 and 65 were rejected under 35 U.S.C. 103(a) as allegedly being anticipated by U.S. Patent No. 6,656,040 issued to Brosnan in view of U.S. Patent No. 6,302,395 issued to Astaneha and further in view of U.S. Patent No. 5,911,418 issued to Adams.

- Claims 52 and 53 were rejected under 35 U.S.C. 103(a) as allegedly being anticipated by  
20 U.S. Patent No. 6,656,040 issued to Brosnan in view of U.S. Patent No. 6,302,395 issued to Astaneha and further in view of U.S. Design Patent No. 273,310 issued to Pohanka.

Applicants respectfully traverse these rejections.

Neither Brosnan nor Astaneha anticipate the independent claims of the present invention for at least the following reasons:

- Neither Brosnan nor Astaneha teach a gaming device that combines a first game having card wagering positions that are dealt by a dealer with a second game that has a rotating wheel.
- Neither Brosnan nor Astaneha teach, disclose or suggest a gaming device that has a game display controlled by a controller that is mounted adjacent a dealer position.
- The combination of Brosnan and Astaneha teaches away from the Applicants invention.
- The combination of Brosnan and Astaneha is not obvious.
- The combination of Brosnan and Astaneha can only be gleaned through hindsight reasoning.

**Neither Brosnan nor Astaneha teach a gaming device that combines a first game having card wagering positions that are dealt by a dealer with a second game that has a rotating wheel**

Brosnan purports to disclose parallel games on a gaming device. Brosnan appears to allow a player to start a new game before the outcome of the previous game is completed. Brosnan does not disclose a dealer position. Astaneha purports to disclose a combination dice, card and roulette gambling table. Astaneha appears to show a single game that combines the numerical values generated by dice, numbered cards and a rotating wheel to obtain a game outcome. The game outcomes are shown on a table layout. Figure 5 of Astaneha shows the table layout. The layout shown is not a roulette layout.

Independent claim 40 of Applicant's application specifically requires a dealer position and at least two individual card wagering positions. The device of Brosnan is a slot machine and

does not have a dealer position. Brosnan does not teach, disclose or suggest the use of a dealer in the game or two card wagering positions. Since Brosnan is a slot machine, it cannot have a dealer position.

Dependent claims 41-55 add additional patentable features and are allowable therewith.

5. For example, claim 51 recites that a rotatable wheel is mounted above a table. None of the cited references teach a wheel mounted above a table.

**Neither Brosnan nor Astaneha teach, disclose or suggest a gaming device that has a game display controlled by a controller that is mounted adjacent a dealer position.**

- 10        Brosnan discloses a game display. The game display is not mounted adjacent to a dealer position. There is no dealer position in Brosnan. Astaneha does not disclose a game display or a game display that is controlled by a controller. The games of Astaneha are manually operated games.

- 15        The amended independent claims of Applicant's present application specifically require a game display that is mounted adjacent a dealer position and is controlled by a controller.

The device of Brosnan is a slot machine and does not have a dealer position. Brosnan does not teach, disclose or suggest the use of a dealer in the game. Since Brosnan is a slot machine, it cannot have a dealer position.

- 20        Because the games of Astaneha are manually operated games, they do not use an electronic control or a controller. Astaneha does not teach, disclose or suggest the use of a controller.

**The combination of Brosnan and Astaneha teaches away from the Applicants invention.**

The alleged combination of cited references fails to anticipate the claimed present invention of independent claim 40. If the slot machine of Brosnan was combined with the dealer, roulette game and adding of generated numbers as shown in Astaneha, the combination would result in a slot machine that is operated by a dealer and that has a roulette game. The results of the slot machine would be added to the results of the roulette game in order to generate a final game outcome as taught by Astaneha (see column 7, lines 2-20).

In contrast, applicant's invention is a table game that allows a game player to play a card game and also to play a supplemental game.

It is therefore respectfully submitted that the references teach away from the alleged combination. The courts have long cautioned that consideration must be given where the references diverge and teach away from the claimed invention. *Akzo v. International Trade Commission*, 1 USPQ 1241, 1246 (Fed. Cir. 1986).

**The combination of Brosnan and Astaneha is not obvious.**

As the Court of Appeals for the Federal Circuit has noted, even if prior art references are combinable to construct an Applicant's invention, the modification is not obvious unless there is a suggestion in the prior art. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicant respectfully submits that there is no motivation or suggestion in either Brosnan or Astaneha to modify Brosnan to include a table, a live dealer position and a roulette game and that the claims are patentably distinguishable over the art of record.

Particularly, it is noted that Brosnan does not recognize the problems which Applicant's invention addresses and solves; i.e., 1) the problem of player boredom on table games, such as

blackjack and 2) the desire to increase revenues for table games, such as blackjack. Brosnan does not suggest or recognize these problems. Had Brosnan (instead of Applicant) recognized this problem, he would have disclosed a table game with a dealer position and not a slot machine.

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**The combination of Brosnan and Astaneha can only be gleaned through hindsight reasoning.**

The Federal Circuit has also stated that either a showing of some objective teaching in the prior art or the knowledge generally available to one of ordinary skill in the art must lead an individual to combine the relevant teachings of the references. *In Re Fine*, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citing *In Re Lahu*, 747 F2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). A rejection based on 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, there is an initial burden of supplying the factual basis for the rejection advanced. One may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

It is doubtful that one skilled in the art of designing table games would be motivated or inclined to look at slot machines in order to design new and interesting table games that are entertaining for game players.

As described above, and because Brosnan or Astaneha both fail to even recognize the problems solved by the present invention, it would appear that the Office's obviousness determination was reached only after having considered the subject of Applicant's invention rather than the teachings of the prior art or the knowledge of those of ordinary skill in the art.

Because the cited references do not teach, disclose or suggest all limitations of Applicant's claims, Applicants respectfully request the Office to withdraw the 103(a) rejection.

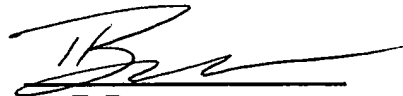
**Conclusion**

5. For all of the above reasons, the Applicants submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or amendment, the Examiner is encouraged to call the Applicants' attorney at (775) 826-6160.

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Respectfully Submitted,

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